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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,182	06/19/2002	William A. Banks	01017/36667	7965

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EXAMINER

KOLKER, DANIEL E

ART UNIT PAPER NUMBER

1646

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,182

Applicant(s)

BANKS, WILLIAM A.

Examiner

Daniel Kolker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2002, 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 - 10, drawn to methods of modulating the transport of leptin across the blood-brain barrier.

Group II, claim(s) 11 - 22, drawn to methods of modulating body weight.

Group III, claim(s) 23 - 32, drawn to methods of modulating appetite.

Group IV, claim(s) 33 - 39, drawn to pharmaceutical compositions.

Group V, claim(s) 40 - 56, 58, drawn to the use of compounds for the manufacture of medicaments for modulating the transport of leptin across the blood-brain barrier.

Group VI, claim(s) 57, 59 - 76, drawn to the use of compounds for the manufacture of medicaments for modulating the body weight of an animal.

The inventions listed as Groups I - VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The first stated special technical feature is the administration of an effective amount of one or more compositions selected from the group consisting of adrenergic agonists, adrenergic antagonists, neurotransmitters, cytokines, amino acids, opiate peptides, purinergic agonists, glutaminergic agonists and metabolites thereof. The administration of adrenergic agonists and antagonists to mammals is not a contribution over the prior art. For example, Greenway et al.

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(U.S. Patent 4,525,359, issued 25 June 1985) teach the administration of isoproterenol and yohimbine to mammals (see abstract, as well as column 4, line 65, and claims 1 and 16, for example). Therefore the administration of one of the above-listed compounds is not a special technical feature.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Group A: agents that modulate leptin transport across the blood-brain barrier

- a) epinephrine
- b) isoproterenol
- c) arterenol
- d) cirazoline
- e) yohimbine
- f) phentolamine
- g) prazosin
- h) benoxanthian
- i) TNF-alpha
- j) tyrosine
- k) adenosine
- l) glutamate
- m) opiate peptides
- n) a metabolite of one of the above-listed compounds

Group B: Leptins

- a) SEQ ID NO: 2
- b) SEQ ID NO: 4
- c) SEQ ID NO: 5
- d) SEQ ID NO: 6
- e) a consensus leptin, defined by structure
- f) a leptin variant, defined by structure
- g) a leptin analog, defined by structure

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- h) a leptin fusion protein, defined by structure
- i) a chemically modified derivative of leptin, defined by structure
- j) a fragment of one of the above, defined by structure

Applicant is required, in reply to this action, to elect a single species from *each of the two groups listed above*, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Group A:

Species a – d correspond to claims 5, 16, 27, 34, 41, 58

Species e – h correspond to claims 6, 20, 28, 35, 43, 60

Species i corresponds to claims 7, 18, 29, 36, 47, 64

Species j corresponds to claims 8, 17, 30, 37, 49, 66

Species k corresponds to claims 9, 21, 31, 38, 52, 69

Species l corresponds to claims 10, 22, 32, 39, 54, 71

Species m corresponds to claims 50, 67

Group B:

All species are listed in claims 3, 4, 13, 14, 25, 26, 33, 56, and 73

The following claim(s) are generic: 1 – 4, 11 – 15, 23 – 26, 33, 40, 44 – 46, 48, 50, 51, 53, 55 – 57, 59, 61 – 63, 65, 67, 68, 70, 72, and 74 – 76.

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The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: In both groups A and B, the species correspond to chemically distinct entities with different physical and biological properties.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.


In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kolker whose telephone number is (571) 272-3181. The examiner can normally be reached on Mon - Fri 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on (571) 272-0829. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHARON L. TURNER, PH.D.
PATENT EXAMINER

1-31-05

Daniel E. Kolker, Ph.D.